

REMARKS/ARGUMENTS

In the Office Action, claims 1-23 are subject to a restriction requirement, the claims and specification are objected to, and claims 1-5 are rejected.

I. Restriction Requirement

Pursuant to the Restriction Requirement, Applicant provisionally elects claims 1-5 for continued prosecution herein.

Claims 1-23 have been subjected to restriction under 35 U.S.C. § 121. Specifically, the Official Action avers that the following inventions are present in the claims:

I. Claims 1-5, drawn to a kit including a shaping device, patch, and suture, and method of selecting appropriate size for components; and

II. Claims 6-23, drawn to a method for treating ischemic congestive heart failure.

It is the Examiner's position that the inventions listed as Groups I – II are distinct from each other.

In response to the Examiner's requirement for restriction, Applicant provisionally elects to prosecute the subject matter of Group I, Claims 1-5, as elected during the telephone conversation on September 8, 2006. However, applicants reserve the right under 35 U.S.C. §121 to file one or more divisional applications directed to the non-elected claims in this application.

II. Objections to the Specification

The Examiner objects to the Abstract because it is not informative. In response, the Abstract has been amended to include a more informative description of the invention.

The Examiner objects to the disclosure because paragraph [0001] contains an incorrect date for U.S. Patent Application 10/127,714. In response, the paragraph has been amended to correct the date.

The Examiner further objects to the disclosure because paragraph [0027] refers to a “suture device”, while paragraph [0028] refers to a “shaping suture” and paragraph [0030] refers to a “shaping suture device”. In response, paragraphs [0028] and [0030] have been amended to refer to a “suture device”, consistent with paragraph [0028].

The Examiner further objects to the disclosure because paragraph [0142] incorrectly refers to the handle as “1342” and not “132”. In response, the paragraph has been amended to refer to the handle as 132.

In view of the above, Applicant respectfully requests withdrawal of the objection to the specification.

III. Objection to the Claims

The Examiner objects to Claims 1, 2 and 4 because claim 1 refers to a “shaper”, while claims 2 and 4 refer to a “shaping device”, and states that one term should be used for consistency.

Applicant respectfully submits that claims 1, 2 and 4 are independent claims, and therefore there is no antecedent basis at issue in the claims. The specification refers to a shaping device and a shaper, and elements may be referred to in the claims as such if support is provided in the specification.

Accordingly, Applicant respectfully requests withdrawal of the objection to the claims.

IV. Claim Rejections Under 35 U.S.C. § 102

Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent No. 6,681,773 to Murphy et al. (hereafter “Murphy”).

The Examiner alleges that Murphy discloses each of the elements of independent claims 1, 2, 4 and 5. Applicants respectfully disagree for the reasons pointed out below.

Independent claim 1 clearly recites that the patch is selected to be an appropriate size for a patient, where the patch size is determined at least in part according to the shaper selected. Independent claim 2 clearly recites that the patch is sized according to the size of the shaping device such that the patch is also appropriately sized for the patient.

Murphy, on the other hand, teaches using a set of sizers to determine the size of the patch. In Col. 10, line 45 – Col. 12, line 39, Murphy teaches using set of sizers set of sizers 402a-402d, which are shaped to be the approximate size of the patch 300 (FIG. 3a). A handle 404 includes a shaft 408 having a proximal end 410 and a distal end 412. The distal end 412 couples to the connection 406 of the sizers 402a-402d. The proximal end 410 is coupled to a hand grip 414. The hand grip 414 is sized to fit a human hand. A surgeon connects any of the sizers 402a-402d to the handle 404. The use of handle 404 with a sizer allows the surgeon to easily estimate the size of the opening to be patched by holding the sizer up to and into the opening. If the sizer is too small, another one may be selected. This process may be repeated until the surgeon feels he has a sizer of the correct shape and size. As will be explained in greater detail below, once the proper size has been determined the sizer may be placed on material and be used as a template to cut the patch 300 to the appropriate size.

Accordingly, Murphy uses a set of sizers to estimate the size of the opening, and then cuts a patch accordingly (Col. 11, lines 2-10), or uses a set of pre-cut patches, with each pre-cut

patch corresponding to a sizer (Col. 11, lines 54-64). Accordingly, Murphy relies on a set of sizers to determine the size of an opening to select a patch, it does not select a patch according to the shaper or shaping device, as recited in independent claims 1-2.

Independent claim 4 recites a kit comprising a shaping device and a suture, where the suture is sized according to a size of the shaping device. Independent claim 5 recites a kit having a patch and a suture, where the suture is sized according to a size of the patch. Murphy, on the other hand, simply teaches suturing a patch using a suture hook. As described in Col, 12, lines 40-47, a suture hook 520 has a long leg 522, and coupled to long leg 522, is short leg 524. The suture hook 520 is adapted to be used to pull up on the sutures in the patch 300 to secure the patch 300 to the heart. Murphy does *not teach sizing of the sutures*, and more so, does not teach sizing the sutures according to a size of a shaping device or a size of a patch, as recited in independent claims 4-5.

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). Accordingly, as Murphy fails to teach the features of independent claims 1, 2, 4 and 5 as discussed above, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection of the claims is improper.

In view of the above, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(b) rejection of claims 1, 2, 4 and 5 as being allegedly anticipated by Murphy.

V. Claim Rejections Under 35 U.S.C. § 103

Claim 3 is rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Murphy as applied to claim 2, and further in view of U.S. Patent No. 5,454,834 to Boebel et al. (hereafter “Boebel”).

Claim 3 is dependent on claim 2, and incorporates all of the limitations of independent claim 2 and recites additional unique elements and/or limitations. Accordingly, claim 3 remains patentable because the additional cited reference of Boebel does not supply the elements with respect to independent claim 2. As such, it is respectfully submitted that claim 3 is in allowable form.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claim 3 as being allegedly unpatentable over Murphy in view of Boebel.

VI. Conclusion

In view of the aforementioned remarks and amendments, the Applicants believe that each of the pending claims is in condition for allowance. Accordingly, Applicants respectfully request allowance of claims 1-5.


If, upon receipt and review of this amendment, the Examiner believes that the present application is not in condition for allowance and that changes can be suggested which would place the claims in allowable form, the Examiner is respectfully requested to contact Applicants' undersigned counsel at the number provided below.

Extension Fees

Applicant believes that a one month extension fee is due. Please charge such fee and any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 03-1250 (Ref. No. 12080027.000019).

Respectfully submitted,

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